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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,118	12/04/2000	James Norman Cawse	RD-27,953	6825
7590	03/23/2004		EXAMINER EPPERSON, JON D	
Philip D Freedman Attorney at Law 6000 Wescott Hills Alexandria, VA 22315-4747			ART UNIT 1639	
PAPER NUMBER				

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,118

Applicant(s)

CAWSE, JAMES NORMAN

Examiner

Jon D Epperson

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10, 16 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 16 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. The Response filed December 17, 2003 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of the Claims

3. Claims 1-7, 10 and 16 were pending. Claim 1 was amended and claims 37-40 were added. Therefore, claims 1-7, 10, 16 and 37-40 are pending.

Withdrawn Objections/Rejections

4. The New Matter rejections under 35 U.S.C. § 112 are withdrawn in view of Applicant's amendments and/or arguments. All other rejections are maintained and the arguments are addressed below.

Outstanding Objections and/or Rejections

Claim Rejections - 35 USC § 103

5. Claims 1-7, 10, 16 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eigen et al. (US Patent No. 5,447,679) (Date of Patent is **September 5, 1995**) and

Bottenbruch et al. (US Patent No. 4,086,310) (Date of Patent is **April 25, 1978**) and Bayer (Bayer “Mackrofol BL” Application Technology Information **March 21, 1998**, 1-6).

For *claims 1, 10, 16 and 37-39*, Eigen et al. (see entire document) teach a polycarbonate substrate with an array of reactions cells that contains a polycarbonate monofilm covering (i.e., each of the wells contains “two opposing walls”, a concave bottom, and “comprises” a polycarbonate monofilm covering) (see Eigen et al., figures 1-5 and 10; see especially elements 2, 11 and 49; see also column 1 paragraphs 1-3). Furthermore, Eigen et al. teach that this polycarbonate film is sealed to cover at least one cell (e.g., see column 7, line 60; see also figure 10). In addition, Eigen et al. teach heat-sealing the polycarbonate film (e.g., see Eigen et al., column 9, lines 39-62; see also column 10, line 6 and 35-40 wherein the heat welding process is disclosed; see also figure 10). Finally, Eigen et al. disclose that not all of the cells need to be covered with polycarbonate e.g., only in situations where the volume in the cells is small (e.g., see column 7, lines 59-60).

Please note that the limitation of “a reactor plate for combinatorial investigation of the catalytic production of aromatic carbonates” in claim 1 represents functional language describing a use of the apparatus, which wouldn’t further limit the scope of the claimed invention. See MPEP § 2114:

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teach all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

The prior art teachings of Eigen et al. differ from the claimed invention as follows:

For *claims 2-7*, Eigen et al. is deficient in that it does not specifically teach the use of a “permeable film” that can selectively permit transport a reactant gas into the one cell while preventing transport of a reaction product out of the cells. Eigen et al. is also deficient in that it does not teach a permeable polycarbonate film that selectively admits transport of oxygen and carbon monoxide and prohibits transport of a diary carbonate. Eigen only teach the use of a polycarbonate film that covers the wells of the polycarbonate substrate wherein the film is 0.1 mm thick (e.g., see Eigen et al., column 8, paragraphs 1, 4 and 6).

Eigen et al. is also deficient in that it does not teach a permeable film that is characterized by a diffusion coefficient of 5×10^{-10} to 5×10^{-7} ; or of 1×10^{-9} to 1×10^{-7} ; or of 2×10^{-8} to 2×10^{-6} cc(STP)-mm/cm² – sec cm-Hg. Furthermore, Eigen et al. is deficient in that it does not teach a permeable film that is between .0002 to .05 mm; or between .005 to .04 mm; or between .01 to .025 mm thick. Eigen et al. only shows polycarbonate films that are 0.1 mm thick.

However, the combined teachings of Bottenbruch et al. and Bayer teach the following limitations that are deficient in Eigen et al.:

For *claims 1-7 and 10*, Bottenbruch et al. (see entire document) teach the use of polycarbonate monofilms that are commercially available at .002 mm thickness (e.g., Makrofol from Bayer) and also provide several other examples wherein the thickness is less than .002 mm e.g., .1 μ m (see Bottenbruch et al., column 1, lines 47-50; see also

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Examples 1-3 and claim 3). Furthermore, Bottenbruch et al. teach that these polycarbonate films are permeable especially to oxygen and carbon dioxide and that this “permeability is inversely proportional to the thickness of the film” (see Bottenbruch et al., column 1, paragraphs 4-5; see also column 4, paragraph 4) (see also Bayer, page 2, column 2 showing various thickness for the polycarbonate film).

The limitations wherein the film “selectively permit transport of a reactant gas into the one cell while preventing transport of a reaction product out of the cells” and “selectively admits transport of oxygen and carbon monoxide and prohibits transport of a diary carbonate” in claim 1 are also anticipated because these limitations are inherent properties of the “polycarbonate film” disclosed by Bottenbruch et al. and Bayer or, in the alternative, would be construed as functional language describing a use of the apparatus, which wouldn’t further limit the scope of the claimed invention. See MPEP § 2114:

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teach all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

However, in the alternative that the functional language in claim 1 (e.g. the selective permeability) is to be considered as additional limitations for claim 1, the claimed invention would still be anticipated by the combined teachings of Bottenbruch et al. and Bayer. For example, Bottenbruch et al. and Bayer teach the same polycarbonate film with the same thickness as that claimed by applicant. Furthermore, Bottenbruch et

al. teach that the permeability depends on the thickness and shows that their polycarbonate membrane is selectively permeable to oxygen and carbon monoxide (see Bottenbruch et al., column 1, lines 47-50; see also Examples 1-3 and claim 3; see also column 1, paragraphs 4-5; see also column 4, paragraph 4; see also Bayer, page 2, column 2 showing various thickness for the polycarbonate film). Although Bottenbruch and Bayer never explicitly state that their polycarbonate films would not be permeable to larger hydrocarbons like diaryl carbonate, the permeability is expected to be the same as that disclosed by applicant because the film is made out of the same polycarbonate material and has the same thickness as that claimed by applicants. Furthermore, Bottenbruch et al. provides examples of other hydrocarbons i.e., propane and natural gas (see Bottenbruch et al., column 4, lines 40-41) that have significantly lower permeability than oxygen and carbon dioxide which would further indicate that larger hydrocarbons like diaryl carbonate would not be permeable. "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The Office does not have the facilities to make such a comparison and the burden is on the applicants to establish the difference. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray*, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

Furthermore, the limitations of diffusion (see claims 2-4) are also met because Bottenbruch et al. teach that the diffusion coefficient is an inherent property of the polycarbonate material and its thickness (see Bottenbruch et al., column 1, paragraphs 4-

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5; see also column 4, paragraph 4) and, as a result, the polycarbonate films disclosed by Bottenbruch et al. and Bayer must have the same diffusion coefficients because they are made of the same material and have the same thickness. "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The Office does not have the facilities to make such a comparison and the burden is on the applicants to establish the difference. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray*, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

It would have been obvious to one skilled in the art at the time the invention was made to make a polycarbonate microtiter plate with a polycarbonate film covering as taught by Eigen et al. with the gas permeable polycarbonate films as taught by Bottenbruch et al. and Bayer because the most preferred embodiments of Eigen et al. require polycarbonate films with a thickness of about 0.1 mm (e.g., see Eigen et al., column 8, lines 19-21), which is exactly was is disclosed by the combined teachings of Bottenbruch et al. and Bayer i.e., the references represent analogous art (e.g., see Bayer, page 2, column 2, Makrofol BL 95/812). In addition, a person of skill in the art would have been motivated to use the polycarbonate films disclosed by the combined teachings of Bottenbruch et al. and Bayer as a covering for the plastic plates of Eigen et al. because some of the most preferred embodiments disclosed by Eigen et al. require polycarbonate covers and the combined teachings of Bottenbruch et al. and Bayer show that these films

are commercially available which would impart immediate cost and convenience advantages.

Furthermore, one of ordinary skill in the art would have been motivated to use the plastic plates as taught by Eigen et al. with the polycarbonate films as taught by Bottenbruch et al. and Bayer et al. because the favorable chemical and/or physical properties of the film when added as a covering on the plastic plates increase the value and/or use of the plastic plates (e.g., tailor made thickness, favorable gas permeability, ease of manufacture, high heat distortion point, electrical insulating capacity, favorable dielectric constants, favorable thermal stability) (see Bottenbruch et al., column 1, see also Bayer entire document, especially Mechanical Properties, Thermal properties, chemical resistance, etc.), which would prevent contamination and/or degradation of materials placed inside the plastic plates even under unfavorable conditions like high temperatures. For example, the plates of Eigen et al. are designed to rapidly undergo changes in temperature (e.g., see Eigen et al., column 2, especially lines 60-68, "This solves the object of the invention in full ... Due to the small wall thickness and the large heat-exchanging surface, rapid heat exchange is guaranteed through the wells. When the heat-exchanging surface of the wells is brought into contact with a heating or cooling substance having a temperature different that that of the solutions contained in the wells, the latter will assume the new temperature within the time of a few second"). Thus, the "thermally stable" Makrofol BL polycarbonate film coverings (e.g., see Bayer, page 2, Thermal properties section, "Makrofol BL is noted for its good dimensional stability at high temperatures") would be especially beneficial when combined with the "heat-

exchanging” plates of Eigen et al.. because the film will not break down during these rapid temperature changes i.e., the film is thermally stable.

Finally, one of ordinary skill in the art would have reasonably expected to be successful because Bottenbruch et al. teach several successful examples of making thin gas permeable polycarbonate films, Bayer shows their commercial success and that they can be “tailor made” (e.g., see Bayer, page 2, column 2, “Special thickness ... are available on request”; see also Makrofol BL 95/812 showing the most preferred thickness required by Eigen et al.) and Eigen et al. teach that polycarbonate films can be used to cover their disclosed polycarbonate microtiter plates (see Bottenbruch et al., Examples 1 and 2; see also Eigen et al., entire document, see Bayer, entire document).

Response

6. Applicant’s arguments directed to the above 35 U.S.C. § 103(a) rejection were considered (and are incorporated in their entirety herein by reference) but were not deemed persuasive for the following reasons. Please note that the above rejection has been modified from its original version to more clearly address applicants’ newly amended and/or added claims and/or arguments.

[1] Applicants argue that “economics” and “convenience” are not proper reasons to combine the references as required by *In re Lee* and *In re Oetiker* (e.g., see 12/17/2003 Response, pages 7-10).

[2] Applicants argue that the references are improperly combined only through hindsight (e.g., see 12/17/2003 Response, page 10, paragraph 4).

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[3] Applicants argue that the combination of references do not teach or suggest a film that “selectively permits transport of a reactant gas comprising oxygen and carbon monoxide into the at least one cell while preventing transport of a diary carbonate reaction product out of the at least one cell” or any of the diffusion coefficient limitations because “nowhere do Botenbruch et al. and Bayer teach the ‘same polycarbonate’” (e.g., see 12/17/2003 Response, pages 10-12)

This is not found persuasive for the following reasons:

[1] First, the Examiner notes the Examiner notes that the original 35 U.S.C. § 103(a) rejection has been amended to more clearly define the motivation to combine the references. For example, a person of skill in the art would have been motivated to use the “Makrofol BL” polycarbonate film because of its favorable physical and/or chemical properties (e.g., see Bayer, page 2, column 2, “Makrofol BL is noted for its good dimensional stability at high temperatures”). The Examiner contends that these favorable physical and/or chemical properties represent strong motivation to combine said references because a “beneficial result” would have been produced by their combination e.g., see *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). Here, the beneficial result is the formation of plastic plates with “thermally stable” polycarbonate film coverings. The plates of Eigen et al. are designed to rapidly undergo changes in temperature (e.g., see Eigen et al. column 2, especially lines 60-68, “This solves the object of the invention in full ... Due to the small wall thickness and the large heat-exchanging surface, rapid heat exchange is guaranteed through the wells. When the heat-exchanging surface of the wells is brought into contact with a heating or cooling substance having a temperature different that that of the solutions contained in the wells, the latter will assume the new temperature within the time of a few second”). Thus, the Makrofol BL polycarbonate film

covering would be especially beneficial when combined with these “heat-exchanging” plates of Eigen et al.. because the film will not break down during these rapid temperature changes.

Second, the Examiner notes that the “commercial availability” of “tailor made” (e.g., see Bayer, column 2, “Special thickness ... are available upon request”) polycarbonate films as disclosed by the combined teachings of Bottenbruch et al.. and Bayer also represent strong motivation to combine the references because polycarbonate films are required by the most preferred embodiments of Eigen et al. (e.g., see column 8, lines 19-29, “The material preferably used for the cover film 49 is, as already mentioned, a polycarbonate having a thickness of 0.1 mm). Furthermore, the standards set forth by *In re Lee* and *In re Oetiker* have not been violated because all three references represent analogous art (i.e., they all disclose polycarbonate films) and the motivation to combine is not illogical. The combined teachings of Bottenbruch et al.. and Bayer disclose a commercially available source for polycarbonate films with a thickness in the most preferred range of Eigen et al.. (e.g., see Bayer, page 2, Makrofol BL 95/812, see also following section, “Special thicknesses ... are available on request”) and thus their combination would be entirely logical.

Finally, the Examiner notes that “there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention”, see MPEP § 2144”).

[2] In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

[3] First, the Examiner notes that the functional limitation of transporting gasses is not provided any patentable weight because describing a use of an apparatus doesn't further limit the scope of the claimed invention. See MPEP § 2114:

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

"[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teach all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Second, the Examiner notes that the combined references to site the same polycarbonate film as that claimed by Applicant because the only structural limitations claimed by Applicant is that it is made of polycarbonate and has the recited thickness in the claim. Both of these limitations are met by the combined references. Furthermore, since the references do teach the same polycarbonate film as that claimed by Applicant, the film should have the exact same properties.

Accordingly, the 35 U.S.C. § 103(a) rejection cited above is hereby maintained.

New Rejections

Claims Rejections - 35 U.S.C. 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 40 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention. This is a new matter rejection.

Claim 40 was added in the 12/17/2003 Response. Applicants state that “[s]upport for the new claims is found at page 4 of the specification, lines 5 to 14” (e.g., see 12/17/2003 Response, page 6, paragraph 1). However, no support for this amendment is found. Specifically, the Examiner does not find support for the limitation wherein “at least one other cell is covered with a different film” in claim 40. If applicant believes this rejection is in error, applicant must disclose where in the specification support for this amendment can be found in accordance with MPEP 714.02. Therefore, claim 40 represents new matter.

Claims Rejections - 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-7, 10 and 37 are rejected under 35 U.S.C. 102(a,e) as being anticipated by Hirahara et al. (US # 6,045,208) (Date of Patent: **April 4, 2000**; Filed: **July 11, 1995**).

For *claims 1 and 10*, Hirahara et al. disclose a plate (i.e., an electroforming stamper) with an array of reactions cells (see Hirahara et al., Figure 29a, element 26a showing a plate with an array of cells), which anticipates claims 1 and 10 wherein a “substrate comprising an array of reaction cells” is claimed. In addition, Hirahara et al. also disclose a “polycarbonate resin film 29a with a thickness of about 20 μm ” (see Hirahara et al., column 38, lines 45-45, and figure 29a, element 29a), which also anticipates claims 1 and 10 wherein a polycarbonate film is sealed to cover the at least one cell.

The limitations of “transport[ing] a reactant gas comprising oxygen and carbon monoxide” and “preventing transport of a diaryl carbonate reaction product” in claim 1 should not be considered as limitations for this apparatus because these limitations represent functional language describing a use of the apparatus. See MPEP § 2114:

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

However, in the alternative that the functional language in claim 1, the claimed invention would still be anticipated by Hirahara et al. Hirahara et al. disclose a

“polycarbonate resin film” that can be “20 μm ” thick (see Hirahara et al., column 38, line 46), which anticipates claims 12 since applicant has claimed in the specification that “[t]he permeability of a film will vary with thickness” and disclose examples of films with the desired permeability that are “about” the same thickness as the “polycarbonate resin film” claimed by Hirahara et al. (see specification, page 4, bottom two paragraphs). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The Office does not have the facilities to make such a comparison and the burden is on the applicants to establish the difference. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray*, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

For **claims 2-7**, Hirahara et al. disclose a “polycarbonate resin film” that is “20 μm ” thick, which anticipates claims 5-7 wherein the film is “about .0002 to about .05 mm thick” or “about .005 to about .04 mm thick” or “about .005 to about .04 mm thick” (see Hirahara et al., column 4, line 18), which anticipates claims 5-7. Furthermore, although Hirahara et al. do not explicitly recite the diffusion coefficients expressed in claims 2-4, Hirahara et al. still anticipates these limitations because Hirahara et al. disclose examples of films that are made of polycarbonate and are of the same thickness as that disclosed by Applicants. Since Applicant has acknowledged that “[t]he permeability of a film will vary with thickness” (see specification, page 4, bottom two paragraphs) it is logical to conclude that films with the same thickness made from the same material will have the same diffusion coefficient. “When the PTO shows a sound basis for believing that the

products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The Office does not have the facilities to make such a comparison and the burden is on the applicants to establish the difference. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray*, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

For *claim 37*, Hirahara et al. disclose wells with “two opposing walls comprising a permeable film” (see Hirahara et al., figure 29a, element 26a), which anticipates claim 37.

Conclusion

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

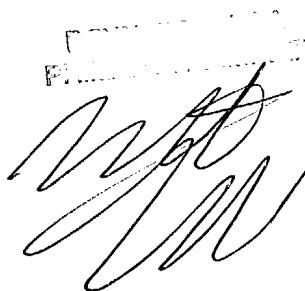
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.

March 21, 2004

A handwritten signature in black ink, appearing to be 'J. D. Epperson', is written over a rectangular stamp. The stamp contains some text that is mostly illegible due to the signature and the quality of the scan, but it appears to be an official mark or seal.